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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91237315
Party	Defendant Universal Life Church Monastery Storehouse
Correspondence Address	MICHAEL P MATESKY II MATESKY LAW PLLC 4500 9TH AVE NE SUITE 300 SEATTLE, WA 98105 UNITED STATES Primary Email: trademarks@mateskylaw.com Secondary Email(s): mike@mateskylaw.com, litigation@mateskylaw.com, mike@psbizlit.com 206-701-0331
Submission	Brief on Merits for Defendant
Filer's Name	Michael P. Matesky, II
Filer's email	mike@mateskylaw.com, litigation@mateskylaw.com
Signature	/Michael P. Matesky, II/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AMERICAN MARRIAGE
MINISTRIES,

Opposer/Plaintiff,

v.

UNIVERSAL LIFE CHURCH
MONASTERY STOREHOUSE,

Applicant/Defendant.

Opposition No. 91237315

DEFENDANT'S TRIAL BRIEF

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I. INTRODUCTION

The Board should deny AMM's opposition, and Application No. 87430729 for the GET ORDAINED mark should proceed to registration, because AMM has failed to prove any of the asserted grounds for opposition. More specifically, AMM failed to prove that the GET ORDAINED mark (1) is generic, (2) is merely descriptive, is not inherently distinctive, and has not acquired distinctiveness, or (3) fails to function as a mark. *See* 1 TTABVue 1-2.¹

First, AMM relies almost exclusively on evidence that is inadmissible under the Federal Rules of Evidence, Federal Rules of Civil Procedure, and Board precedent. As set forth in Appendix A, AMM sandbagged this case by withholding responsive documents and failing to disclose expert opinion testimony prior to trial. AMM's trial exhibits lack authentication, and the testimony of AMM's witnesses is largely without foundation, not based on personal knowledge, and constitutes inadmissible hearsay and/or speculation.

Second, despite the self-serving nature of AMM's witness testimony, could not provide a single witness willing to testify that the "GET ORDAINED" trademark is used or understood as the common name for the category services covered in the Application (i.e., that it is generic). To the contrary, both parties' witnesses agreed that terms such as "ecclesiastical services" or "religious services" are the common names for those services, and that the phrase "GET ORDAINED" refers to an act of the individual, not the services provided by an organization. Accordingly, AMM's genericness claim should be rejected.

Third, the evidence shows that the phrase "GET ORDAINED" has multiple potential

meanings in the context of religious services, and therefore does not *directly* describe the services provided by ULC Monastery. Moreover, because the evidence shows that the phrase “GET ORDAINED” does not describe a characteristic of the applied-for services, but an act or experience of the individual, the GET ORDAINED mark is not descriptive of the applied-for services.

Fourth, the evidence shows that the “GET ORDAINED” mark used by ULC Monastery has acquired distinctiveness through ULC Monastery’s consistent and prominent trademark use in connection with the applied-for services for over a decade. During that time, ULC Monastery has provided the applied-for services under the GET ORDAINED trademark to hundreds of thousands of ministers, spent nearly \$1 million in advertising under the GET ORDAINED mark, and completed over \$10 million in sales through its online store services offered under the mark. Such evidence is sufficient to show that the mark has achieved secondary meaning in the minds of the relevant public, and AMM provides no probative, admissible evidence to the contrary.

Fifth, AMM has not provided any precedent or evidence supporting its claim that the GET ORDAINED mark fails to function as a mark. AMM’s argument appears to be that words or phrases cannot be used or recognized as trademarks if they appear in a stylized format. AMM cites no authority for this position, and the TMEP contradicts AMM’s position. The evidence shows that ULC Monastery consistently used the words GET ORDAINED in a trademark manner in locations commonly used for trademarks—including in non-stylized forms—and that the words are understood as a trademark. Thus, AMM’s “failure to function as a mark” claim should be rejected.

¹ AMM’s fraud claim was previously dismissed with prejudice. 17 TTABVUE 5. Although AMM initially identified that it would pursue a “functionality” claim, it submitted no evidence or argument in support of such a claim. *Compare* 1 TTABVUE 1-2, *with* 88 TTABVUE.

II. EVIDENCE OF RECORD

Without waiving the objections set forth in Appendix A, the evidentiary record consists of:

1. Application No. 87430729 and the application file thereof;
2. Plaintiff's Notice of Reliance and Exhibits A-H and L-T² thereto, as modified by Plaintiff's subsequently filed Notice of Errata. 39-44 TTABVUE.
3. The September 4, 2020 testimony deposition of Dylan Wall and exhibits thereto. 69 TTABVUE.³
4. The September 10, 2020 testimony deposition of Glenn Yoshioka and exhibits thereto. 74 TTABVUE.
5. The September 11, 2020 testimony deposition of Lewis King, and exhibits thereto. 73 TTABVUE.
6. The September 10, 2020 testimony deposition of Brian Wozeniak. 70 TTABVUE.
7. The September 9, 2020 testimony deposition of Dallas Goschie and exhibits thereto. 72 TTABVUE.
8. The September 11, 2020 testimony deposition of George Freeman and exhibits thereto. 71 TTABVUE.
9. The December 15, 2020 testimony declaration of George Freeman and exhibits thereto. 62 TTABVUE.

² The Board struck Exhibits I-J from Plaintiff's Notice of Reliance. 77 TTABVUE 9. Although the Board did not strike Exhibits U-Y to Plaintiff's Notice of Reliance, those exhibits are duplicative of the testimony deposition transcripts and exhibits thereto subsequently filed by Plaintiff.

³ In addition to identifying testimony deposition transcripts as exhibits to its Notice of Reliance, Plaintiff subsequently filed multiple copies of testimony deposition transcripts for each witness. For example 47 TTABVUE, 55 TTABVUE, and 73 TTABVUE are each transcripts of the September 11, 2020 testimony deposition of Lewis King. Throughout this brief, Defendant will attempt to refer only to the latest version of each document filed by Plaintiff.

10. The December 15, 2020 testimony declaration of Brian Wozeniak and exhibits thereto. 63 TTABVUE (confidential), 64 TTABVUE (public).
11. The December 15, 2020 testimony declaration of Dallas Goschie and exhibits thereto. 65 TTABVUE.
12. Defendant's Notice of Reliance and exhibits thereto. 66 TTABVUE.
13. January 11, 2021 cross-examination deposition of Brian Wozeniak. 82 TTABVUE (confidential), 84 TTABVUE (public).
14. January 11, 2021 cross-examination deposition of Dallas Goschie. 85 TTABVUE.
15. January 12, 2021 cross-examination deposition of George Freeman. 86 TTABVUE.
16. The January 29, 2021 testimony deposition of Lewis King and exhibits thereto. 83 TTABVUE.
17. Plaintiff's Supplemental Notice of Reliance and Exhibits U-Y thereto. 78-80 TTABVUE.

III. EVIDENTIARY OBJECTIONS

Pursuant to TBMP § 801.03 and 37 C.F.R. § 2.128(b), ULC Monastery sets forth its evidentiary objection in Appendix A hereto.

IV. RELEVANT FACTUAL BACKGROUND

A. Defendant's Services and Use of the GET ORDAINED Trademark

Defendant ULC Monastery is a church and Washington non-profit corporation founded in 2006. 62 TTABVUE 2 (¶¶ 4-6). For over a decade, ULC Monastery has operated a website available at the GetOrdained.org domain name, through which it has offered and advertised online

retail store services, conducting religious ceremonies, ecclesiastical services, namely, ordaining ministers to perform religious ceremonies, and provided information regarding religious belief systems. *See* 62 TTABVUE 3 (§§ 8-9); 64 TTABVUE 2-3 (§§ 5, 8-9), 65 TTABVUE 2-3 (§§ 6-8).

Throughout that time, ULC Monastery has prominently displayed the GET ORDAINED trademark in the header of every page on the GetOrdained.org website. 62 TTABVUE 3 (§§ 9-11), 6 (Ex. A), 8 (Ex. B); 64 TTABVUE 4 (§ 15); 65 TTABVUE 3 (§§ 9-11), 7-8 (Ex. A). This means that every single person who joined ULC Monastery as a minister through the GetOrdained.org website saw the GET ORDAINED trademark prominently displayed as they received those ecclesiastical services from ULC Monastery. 64 TTABVUE 4 (§ 16); 62 TTABVUE 3 (GET ORDAINED trademark displayed in header of site since at least 2011). Moreover, since at least 2016, “every person who purchased a product through the online store on the GetOrdained.org website did so through a web page that prominently displayed the GET ORDAINED trademark in the header of that page.” 64 TTABVUE 4 (§ 17).

ULC Monastery has also used the GET ORDAINED trademark in many other, non-stylized forms as well. For example:

- ULC Monastery published copyright notices claiming copyright in the name of “Get Ordained” on the footer of its GetOrdained.org website. 65 TTABVUE 7-8.
- ULC Monastery published an “About” page with the heading “About Get OrdainedTM” and which stated “Here at Get OrdainedTM, legal ordination is just a few clicks away,” “[U]sing Get OrdainedTM is hassle-free,” and “[W]e encourage you to visit the Get OrdainedTM Training Center for assistance.” 65 TTABVUE 10-

11.

- ULC Monastery published contact information identifying the source of its GetOrdained.org website as “Get Ordained™ / Universal Life Church” and “Get Ordained/Universal Life Church.” 65 TTABVUE 7-8, 10-11.
- ULC Monastery telephone operators orally use the GET ORDAINED trademark to refer to the source of ULC Monastery’s ecclesiastical services (e.g., “You became a minister through GET ORDAINED, right?”). 65 TTABVUE 4 (¶ 15).

B. The GET ORDAINED Application and Prosecution History

On April 28, 2017, ULC Monastery filed Application No. 87430729 to register the GET ORDAINED mark in connection with the following services:

Class 35: On-line retail store services featuring clothing in the nature of shirts, hats, and stoles, stationery, business cards, bumper stickers, license plate holders, badges, pens, pins, musical sound recordings, bookmarks, bread, aromatic oil, portfolios, and publications in the nature of books, hand-outs, workbooks, manuals, brochures, and newsletters in the fields of religion, spirituality, marriage, law, and management.

Class 45: Conducting religious ceremonies; Ecclesiastical services, namely, ordaining ministers to perform religious ceremonies; Providing a website featuring information about religious belief systems.

On July 25, 2017, the examining attorney issued an office action requiring that Applicant replace several semicolons with commas in its identification of services. Applicant agreed, and the examining attorney issued a Notice of Publication on August 30, 2017. At no point did the examining attorney reject Applicant’s application on the ground that the GET ORDAINED mark is generic or descriptive for the applied-for services, or require that Applicant demonstrate secondary meaning under Section 2(f). AMM has not disputed any of these facts.

The examining attorney’s decision to approve registration of the GET ORDAINED mark without requiring Section 2(f) evidence (i.e., deciding that the GET ORDAINED mark is inherently distinctive for the applied-for services) is consistent with PTO practice for similar marks. The PTO regularly registers trademarks consisting of the word “GET” followed by a second component, where the second component relates to some characteristic resulting from use of the applied-for goods or services:

Mark	Relevant Goods/Services	Int’l Class	Registration Number
GET TAN	“...non-medicated skin care preparations...”	3	5710865
GET LATHERED	“Skin soap”	3	5764374
GET BIG	“Dietary nutritional supplement”	5	1904065
GET HAIR	“Liquid hair growth products”	5	5741099
GET YOLKED ⁴	“Dietary and nutritional supplements”	5	5758543
GET THE TEA	“Medicinal tea”	5	5654847
GET SOME...SLEEP	“transdermal patches for use in the treatment of lack of sleep”	5	5835272
GET VERIFIED	“... an application providing assistance in credentialing processes and compliance validations related to...qualification verifications...”	9	4857093
GET FRUITY	“Dried fruit products”	29	5724613

4 “Yolked” means “To be in a state of extreme muscular fitness.” 66 TTABVUE 111.

Mark	Relevant Goods/Services	Int'l Class	Registration Number
GET FADED ⁵	"Liquor"	33	5826509
GET THAT RAISE	"Career planning services"	35	5783566
GetCash	"Matching borrowers with potential lenders..."	35	5844542
GET STAFFED UP	"...filling the temporary and permanent staffing needs of businesses...Professional staffing and recruiting services"	35	5844754
GET SCOUTED	"Modeling agency services"	35	5879767
GET CONNECTED	"Business networking and business networking referral services..."	35	5892601
GET ON THE BUS	"Transportation of passengers by bus"	39	5422714
GET NIMBLE	"Physical fitness training services"	41	4665106
GET RIPPED ⁶	"Physical fitness training services"	41	5137759
GET STRETCHY	"Providing fitness training services in the field of stretching"	41	5321763
GET ADMITTED	"Admission consulting services, namely, consulting in the field of college admissions..."	41	3618883
GET FIT	"Health club services..."	41	4220188
GET EDUCATED	"Providing online educational information..."	41	4034179
GET IN THE KITCHEN	"Cooking instruction"	41	5713981

⁵ "Faded" means intoxicated or drunk. 66 TTABVUE 112.

⁶ "Ripped" means "Having an extremely defined physique." 66 TTABVUE 113.

Mark	Relevant Goods/Services	Int'l Class	Registration Number
Get Your CEU ⁷	“Continuing education services...”	41	5869853
GET HEALTHY @	“Health care”	44	5671078
GET HOOKED UP	“Internet based dating, matchmaking and social introduction services”	44	5578107
GET BETTER. GO HOME	“Rehabilitation patient care services”	44	5739217
GET LICENSED, STAY LICENSED	“Regulatory compliance consulting in the field of obtaining and maintaining all required business licenses and permits...”	45	4703730

See 66 TTABVUE 53-109.

Opposer filed its Notice of Opposition on October 18, 2017.

C. Common Names for the Category of Services Provided by ULC Monastery

The witness testimony in this case from both parties is consistent in at least one respect. The common names for the category of services that ULC Monastery and AMM provide are “religious services,” “church services,” “ecclesiastical services,” “sacerdotal services,” or “online ordination services.” 62 TTABVUE 4 (¶ 15), 65 TTABVUE 4-5 (¶ 16), 66 TTABVUE 173:1-12 (D Wall: the category of services provided by ULC Monastery and AMM is “religious services”), 185:2-3 (G. Yoshioka: AMM provides “religious services” and “ecclesiastical services”), 188:15-18 (G. Yoshioka: “I would classify [the services provided by AMM and ULC Monastery] as online ordination services.”), 69 TTABVUE 31:23-24 (D. Wall: “There are many organizations that offer ordination services.”).

There is no record evidence that any person anywhere has ever used the words “get ordained” as the common name for the category of services provided by ULC Monastery. Indeed, in their combined decades of experience, neither ULC Monastery’s presiding chaplain nor its operations manager have ever heard such a use. 62 TTABVUE 3 (§§ 12-14); 65 TTABVUE 4-5 (§ 16).

D. Definitions and Uses of the Phrase “GET ORDAINED”

There is no dictionary definition for the phrase “GET ORDAINED.” 66 TTABVUE 30, 34-35, 37, 39, 44. Although the Merriam-Webster Dictionary provides 26 examples (and even more definitions) of “get” used as an auxiliary verb in combination with other words, it provides no definition for “GET ORDAINED.” 66 TTABVUE 12. However, the component words “get” and “ordained” each have multiple definitions, and are interpreted in different ways.

The Merriam-Webster Dictionary entry for the word “get” has over 14 definitions as a transitive verb (66 TTABVUE 10), over 5 definitions as an intransitive verb (*id.*), and multiple definitions as a noun (66 TTABVUE 12). These definitions include “to leave immediately” and “to obtain or receive by way of benefit or advantage.” 66 TTABVUE 10.

The Dictionary.com entry for the word “ordain” provides four definitions as a transitive verb (“used with an object”) and two definitions as an intransitive verb (“used without an object”). 66 TTABVUE 22. These definitions include “to order or command” and “to destine or predestine.” This entry also identifies “order,” “prescribe,” “determine,” and “predetermine” as synonyms for the word “ordain.” 66 TTABVUE 24; *see also* 66 TTABVUE 52 (use of “ordained” to mean “ordered” or “predetermined”).

7 “CEU” means “Continuing Education Units” and is disclaimed in Reg. No. 5869853. 66 TTABVUE 92, 114.

Thus, based on the dictionary definitions of its component terms, the phrase “GET ORDAINED” in combination could mean anything from “leave immediately, being commanded” to “obtain predestination.” It is not surprising, then, that ULC Monastery’s presiding chaplain, based on his decades of service in the religious field, testified that the phrase “GET ORDAINED” can have multiple meanings to multiple people in multiple contexts. 62 TTABVUE 4 (¶ 18).

However, in the spiritual context, any non-trademark significance of the phrase “GET ORDAINED” refers to a prospective minister’s “recognition of a calling or motivation to fulfill a spiritual purpose.” 62 TTABVUE 4 (¶ 18-19). When the phrase “GET ORDAINED” is used in the manner that trademarks are typically used, in connection with the religious services and online store services provided by ULC Monastery, the word are understood as a trademark. 62 TTABVUE 4-5 (¶ 20); 65 TTABVUE 5 (¶ 17).

Paradoxically, AMM’s witnesses have testified that the phrase “GET ORDAINED” is essentially interchangeable with “become a minister,” e.g., 73 TTABVUE 28:15-21, while at the same time testifying that there is no adequate substitute for the phrase “GET ORDAINED,” e.g., 73 TTABVUE 45:5-8. In reality, before initiating this opposition proceeding, AMM regularly used “apply for ordination,” “become an AMM minister,” and other phrases without any supposed “competitive need” to use ULC Monastery’s GET ORDAINED trademark. 93 TTABVUE 17:16-25, 18:11-15, 21:3-22:1, 23:6-13, 24:22-25, 26:10-14, 27:24-28:1, 29:1-20, 30:13-31:8, 57-58 (“Become an Ordained Minister” and “Become a Minister”), 59-62 (“Become an Ordained Minister” and “Begin Ordination”), 63 (“Become an AMM Minister” and “Apply for Ordination”) 64-70 (“Become a Minister”), 71-72 (“Apply for Ordination”), 73-74 (“Become a Minister” and “Apply for Ordination”), 75-76 (“Become and AMM Minister” and “Apply for Ordination”).

Although ULC Monastery’s witnesses and AMM’s witnesses do not agree on the meaning, use, and understanding of the phrase “GET ORDAINED,” they do agree that the words refer something a prospective minister does, not an act or service the religious organization provides. *See, e.g.,* 62 TTABVUE 4 (¶ 17) (“To ‘get ordained’ is an internal recognition or epiphany of a spiritual calling, which one can only experience within oneself.”); 66 TTABVUE 170:24-171:15 (“I don’t possibly see how United National Ministry could become a minister itself; it’s an organization.”); 69 TTABVUE 42:20-24 (The phrase “get ordained” describes “something that an individual can do.”); 74 TTABVUE 16:11-20 (“Get ordained means the act of...seeking to receive a title or authority...”).

V. LEGAL ARGUMENT AND AUTHORITY

As discussed in detail below, the Board should reject AMM’s opposition because **(A)** AMM failed to prove that the GET ORDAINED trademark is generic for the applied-for services, **(B)** AMM failed to prove that the GET ORDAINED trademark is merely descriptive of the applied-for services, and the evidence shows that it has acquired secondary meaning, and **(C)** AMM failed to prove that the GET ORDAINED trademark does not function as a mark.

A. The GET ORDAINED Trademark is Not Generic

The Board should reject AMM’s genericness claim because AMM has not met its burden of proving that the GET ORDAINED trademark is generic for ULC Monastery’s Class 35 or Class 45 services. Opposer AMM bears the burden of proving that the GET ORDAINED mark is the generic term for the applied-for services. *See Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 114 U.S.P.Q.2d 1827, 786 F.3d 960, 965 (Fed. Cir. 2015). A term is generic in relation to goods or services if it “is the common descriptive name of a class of goods or services.” *Id.* at 965 (quoting *H.*

Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 989 (Fed. Cir. 1986)). “The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term...to refer to the genus of goods or services in question.” *Marvin Ginn*, 782 F.2d at 989-90.

AMM concedes that “[A] proper genericness inquiry focuses on the description of services set forth in the [application or] certificate of registration.” 88 TTABVUE 36. Here, ULC Monastery applied to register the GET ORDAINED trademark in connection with:

Class 35: On-line retail store services featuring clothing in the nature of shirts, hats, and stoles, stationery, business cards, bumper stickers, license plate holders, badges, pens, pins, musical sound recordings, bookmarks, bread, aromatic oil, portfolios, and publications in the nature of books, hand-outs, workbooks, manuals, brochures, and newsletters in the fields of religion, spirituality, marriage, law, and management.

Class 45: Conducting religious ceremonies; Ecclesiastical services, namely, ordaining ministers to perform religious ceremonies; Providing a website featuring information about religious belief systems.

Thus, the Application covers “on-line retail store services” in Class 35 and “ecclesiastical services” in Class 45. AMM does not claim that the GET ORDAINED mark is generic for ULC Monastery’s online store services in Class 35, and has therefore not met its burden with regard to Class 35. Rather, AMM only identifies “ordaining ministers to perform religious ceremonies” in Class 45 as the services for which the GET ORDAINED mark is allegedly generic. 88 TTABVUE 25.

Witnesses for both parties testified that the common names for the category of these services are “religious services,” “ecclesiastical services,” or “online ordination services.” 66 TTABVUE 173:1-12 (the category of services provided by ULC Monastery and AMM is “religious services”), 185:2-3 (AMM provides “religious services” and “ecclesiastical services”), 188:15-18 (“I would classify [the services provided by AMM and ULC Monastery] as online ordination services.”).

Mr. Freeman and Mr. Goschie testified that, in their combined decades of experience, they have never heard anyone use the words “get ordained” to refer to a class of goods or services. 62 TTABVUE 3 (§§ 12-14); 65 TTABVUE 5 (§ 16). AMM has not put forth any admissible evidence to contradict this. Not a single witness has testified that “get ordained” is used or understood as the common name for the categories of applied-for services. No consumer testimony. No competitor testimony. No testimony from survey or marketing experts.

Even the self-serving testimony of AMM’s managers provides no examples of anyone using or understanding “get ordained” as the common name for the class of services provided by religious organizations. To the contrary, the parties agree that the only relevant, non-trademark meaning of “GET ORDAINED” refers to actions undertaken by individuals, not the services provided by a religious organization. 62 TTABVUE 4 (§ 17) (“To ‘get ordained’ is an internal recognition or epiphany of a spiritual calling, which one can only experience within oneself.”); 66 TTABVUE 170:24-171:15 (“I don’t possibly see how United National Ministry could become a minister itself; it’s an organization.”); 69 TTABVUE 42:20-24 (The phrase “get ordained” describes “something that an individual can do.”); 74 TTABVUE 16:11-20 (“Get ordained means the act of...seeking to receive a title or authority. . .”).

Nonetheless, AMM presses its genericness claim based on (1) inapplicable and easily distinguishable legal precedent, (2) self-serving, contradictory, and inadmissible opinion testimony, and (3) inadmissible and non-probative documentary evidence. This is insufficient to meet AMM’s burden of proving genericness.

1. AMM Cites No Relevant Precedent

The paradigmatic genericness cases are not conceptually difficult. “Bread” is the common name for a category of food made from cooked flour. “Church” is the generic term for a class of institutions providing religious services. But AMM has not cited a single case where an imperative phrase (e.g., “get ordained,” “just do it,” “climb higher,” “raise the flag,” etc.) has been held to be generic for any goods or services. The cases cited by AMM are all easily distinguishable: *In re Hikari Sales USA, Inc.*, No. 86439012, 2019 WL 1453259 (T.T.A.B. Mar. 29, 2019) (“algae wafers” generic for algae-based fish food); *Novak v. Overture Servs., Inc.*, 309 F.Supp.2d 446 (E.D.N.Y. 2004) (“PETS WAREHOUSE” not generic as a matter of law); *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2307 n.6 (2020) (“Booking.com” not generic for online travel booking services); *In re Wm. B. Coleman Co., Inc.*, 93 U.S.P.Q.2d 2019 (T.T.A.B. Mar. 4, 2010) (“Electric Candle Company” generic for lighting fixtures); *See In Re Active Ankle Sys., Inc.*, 83 U.S.P.Q.2d 1532 (T.T.A.B. 2007) (“dorsal night splint” generic for “orthopedic splints for the foot and ankle”); *Retail Services, Inc. v. Freebies Publishing*, 364 F.3d 535 (4th Cir. 2004) (“Freebies” generic for publications “about free mail-order offerings.”).

To the contrary, the PTO regularly registers imperative phrases in the form “GET _____” as trademarks. 66 TTABVue 53-113. Such registrations constitute evidence that this form of mark is not generic, but is in fact inherently distinctive. *See Cross Commerce Media, Inc. v. Collective, Inc.*, 120 U.S.P.Q.2d 1517, 841 F.3d 155, 165-66 (2d. Cir. 2016) (“[E]ven where the PTO has not previously considered the particular mark at issue, courts may draw a measure of guidance from the way the agency has classified analogous marks.”); *Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112, 119 (1st Cir. 2006) (“Courts frequently have accorded weight to

these kinds of PTO determinations in evaluating whether a mark is descriptive or inherently distinctive.”).

Indeed, in one of the leading cases regarding the legal distinction between generic and descriptive terms, the Supreme Court held that a registration for the imperative phrase “PARK N’ FLY” could not be cancelled, although it could have been cancelled if it were generic. *See Park ‘N’ Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 105 S. Ct. 658, 83 L.Ed.2d 582, 224 U.S.P.Q. 327 (1985).

2. AMM Relies on Inadmissible, Self-Serving, and Non-Probative Opinion Testimony

AMM apparently could not find any consumers, competitors, survey experts, marketing experts, or other third-parties willing to testify that the phrase “GET ORDAINED” is used or understood primarily as the common name for the applied-for religious services. Instead, it relies on the inadmissible, self-serving, and speculative opinions of its own officers. *See* 88 TTABVUE 26-31. This testimony is inadmissible for the multiple reasons set forth in Appendix A.

Even if the Board were to consider such testimony, it should not be credited because it is self-serving, contradictory, and not probative of the issues. AMM relies on testimony from its former Executive Director Dylan Wall allegedly to prove how third parties use and understand the words “get ordained.” 88 TTABVUE 26-28. Yet, Mr. Wall candidly admitted that he could not really testify as to how third parties use or understand the words “get ordained,” as it would be entirely speculative. 66 TTABVUE 167:2-11 (“I would just be speculating”).

AMM also relies on the testimony of its founder, Glen Yoshioka, to allegedly prove what third parties are thinking when they use the words “get ordained” in Google searches. 88

TTABVUE 29. Mr. Yoshioka had no qualms about speculating under oath, and confidently testified as to the internal thoughts and motivations of third parties he had never met. When asked how he could possibly know or give testimony on the thoughts, intentions, and understandings of others, he could not provide any actual explanation. Rather, he appealed to his own perceived authority—claiming to be the most knowledgeable person in the entire nation (74 TTABVUE 143:5-10)—essentially saying “I know because I know”:

“I know this because this is what I've been doing for a living for pretty much my entire career, and I'm familiar with the tool sets to know how to use this specifically...”

“I know this because I've been doing this for well over a decade, and this is a very important thing for me professionally to help AMM grow and establish its presence in the world.”

74 TTABVUE 18:16-20, 34:9-14.

For example, Mr. Yoshioka testified that Google searches for the phrase “GET ORDAINED” by itself show that the search user does not associate the phrase “GET ORDAINED” with a single source of ordination services. 74 TTABVUE 141:3-18. When pressed to explain the basis for that conclusion, he first says “it’s plainly obvious,” then falls back on “my many years of looking at analytics and Google ads and all this type of data.” 74 TTABVUE 141:22-25. Mr. Yoshioka then states that, “if someone knows what they're looking for in Google they'll type in or search for that specific thing. If someone doesn't know what they're doing they'll probably use the most generic language they can think of.” 74 TTABVUE 141:25-139:6.

But this does not show what any particular user understands any particular search term to mean, one way or another. By Mr. Yoshioka’s logic, users searching for information about specific source of products will search using the associated brands (e.g., NIKE or STARBUCKS), while

users that are not searching for information about a particular source will search using generic terms (e.g., “shoes” or “coffee”). Thus, the fact that they use a term or phrase by itself as a search term tells us nothing about whether they consider it to be a brand or a generic term—it could be either one.

When pressed to explain his conclusion that people searching for “GET ORDAINED” are not searching for a particular entity, he admitted that it’s just because of his personal belief that the phrase is generic. 74 TTABVUE 141:7-12, 142:23-143:10. In other words, the entirety of Mr. Yoshioka’s testimony is simply Mr. Yoshioka assuming the self-serving legal conclusion he hopes to support (“GET ORDAINED” is generic), and dressing it up in supposed “expertise” and pseudo-technical explanations.

AMM also relies upon the opinion testimony of its current Executive Director Lewis King. 88 TTABVUE 30-31. Yet, in addition to being inadmissible for multiple reasons, Mr. King’s testimony is just as speculative and weak as Mr. Yoshioka’s. Mr. King claims that people commonly search Google for “GET ORDAINED online” or “GET ORDAINED in California” (or some similar location), and that this shows that such users understand the GET ORDAINED mark to be the common name for ULC Monastery’s religious and online store services. *See* 88 TTABVUE 30 (and citations therein).

First, this contradicts Mr. Yoshioka’s testimony that searching for “GET ORDAINED” by itself shows that users view it as a generic term. 74 TTABVUE 141:3-18. Second, Mr. King’s testimony is baseless, as those same searches would be perfectly reasonable if well-known trademarks were inserted in the place of “GET ORDAINED.” A person seeking to place an online order for coffee may search for “STARBUCKS online.” A person seeking out a local car dealership

may search for “HONDA in Vermont.” Just like Mr. Yoshioka, Mr. King appears to have started with the legal conclusion he hoped to reach, and then concocted an explanation as to why the Google Trends data supports his predetermined conclusion, when the data just as easily supports the opposite conclusion.

Indeed, Mr. King’s claim that the phrase “GET ORDAINED” is generic for ULC Monastery’s services term is contradicted by his own testimony. More specifically, Mr. King uses the GET ORDAINED trademark to refer to a particular entity that may have provided ecclesiastical services (i.e., the source of the services). 73 TTABVue 25:18-20 (“[W]e can figure out if it was GetOrdained or if it was a ULCM entity or if it was the original ULC or if it was any of the other organizations.”). If the GET ORDAINED trademark were truly generic, it would be incapable of indicating the source of such services. *In re Montrachet S.A.*, 878 F.2d 375, 376, 11 U.S.P.Q.2d 1393 (Fed. Cir. 1989). Whatever Mr. King and AMM may claim to believe, Mr. King’s use shows that he actually believes that the GET ORDAINED mark is perfectly capable of indicating—and does indicate—a particular source of ecclesiastical services.

3. AMM Relies on Inadmissible and Non-Probative Documentary Evidence

AMM relies on dictionary definitions, Google search results, and other publications that are inadmissible and not-probative of its genericness claim. As set forth in Appendix A, the majority of the documentary evidence AMM relies upon is inadmissible. Even if the Board were to consider such documentary evidence, it is not probative of AMM’s claim that GET ORDAINED is the common name for the category of religious services at issue.

For example, the Federal Circuit and the Board have held on multiple occasions that Google search results are not particularly probative of alleged genericness or descriptiveness. *See In re*

Bayer Aktiengesellschaft, 488 F.2d 960, 82 U.S.P.Q.2d 1828, 1833 (Fed. Cir. 2007); *See also Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 U.S.P.Q.2d 1750, 1759 (T.T.A.B. 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014). Yet AMM relies heavily on such results. 88 TTABVue 22, 24, 29-31, 41.

Similarly, AMM relies on dictionary definitions of the constituent elements of the GET ORDAINED mark: “get” and “ordained.” 88 TTABVue 8-9, 36-37. The Federal Circuit has rejected this approach as a matter of law. *See Princeton Vanguard*, 786 F.3d at 967 (One “cannot simply cite definitions and generic uses of the constituent terms of a mark...in lieu of conducting an inquiry into the meaning of the disputed phrase as a whole...”); *see also Beling v. Ennis, Inc.*, 613 Fed. Appx. 924, 926-27 (Fed. Cir. 2015). Yet, there are no dictionary definitions for the phrase “GET ORDAINED.” This is precisely because it is NOT the commonly used or understood term for any class or category of goods or services.

B. The GET ORDAINED Trademark is Distinctive

The Board should reject AMM’s opposition because AMM has failed to meet its burden of proving that the GET ORDAINED mark is merely descriptive. To the contrary, the GET ORDAINED mark is suggestive of the applied-for Class 45 services, and therefore inherently distinctive. Even if the Board were to hold that the GET ORDAINED mark is not inherently distinctive, the admissible evidence shows that the GET ORDAINED mark as acquired distinctiveness as a trademark through ULC Monastery’s long and prominent use.

1. The GET ORDAINED Trademark is Inherently Distinctive

AMM has the burden of proving that the GET ORDAINED trademark is merely descriptive of the applied-for services. *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 1332 (Fed. Cir. 2014). AMM makes no claim that the GET ORDAINED mark is merely descriptive of ULC Monastery’s online store services in Class 35, and has therefore not met its burden with regard to Class 35. With regard to Class 45, AMM claims only that the GET ORDAINED mark is “merely descriptive in the context of ordination services.” 88 TTABVUE 39.

A suggestive mark requires imagination, thought, or perception to reach a conclusion as to the nature of the goods or services with which it is used, while a merely descriptive mark forthwith conveys an immediate idea of the ingredients, qualities, or characteristics of such goods or services. *StonCor Grp.*, 759 F.3d at 1332-33. The evidence demonstrates that the GET ORDAINED mark is suggestive, not descriptive, of ULC Monastery’s ecclesiastical services.

The same defects in AMM’s evidence regarding genericness, addressed *supra*, also undermine AMM’s claim that the GET ORDAINED mark is descriptive, as opposed to suggestive, of ULC Monastery’s ecclesiastical services. For example, AMM relies on the dictionary definitions of the individual component terms “get” and “ordained.” 88 TTABVUE 40 (“Given the common meanings of the words ‘get’ and ‘ordain,’ no imagination or multistage reasoning is required to connect ‘get ordained’ to a service that enables consumers to become ordained ministers.”). Yet, focusing on individual component definitions is insufficient to evaluate the meaning of a compound phrase. *Beling*, 613 Fed. Appx. at 926-27; *StonCor Grp.*, 759 F.3d at 1333.

AMM focuses on testimony of ULC Monastery witnesses that tends to show that the phrase “GET ORDAINED” could be used and understood to have multiple meanings in different contexts.

See 88 TTABVUE 16-17. Although AMM characterizes such testimony as “discrepancies,” that is inconsistent with trademark law and basic English principles. Mr. Freeman testified that the phrase “GET ORDAINED” can have multiple meanings, depending on context, and could potentially describe a wide variety actions, feelings, or services unrelated to Applicant’s applied-for ecclesiastical services. That should not be surprising and certainly isn’t a “discrepancy.”

Words and phrases can have multiple meanings in multiple contexts. That is why, for example, the dictionary entry for “get” contains numerous different definitions. 66 TTABVUE 12. Words and phrases can be primarily understood as a trademark when used as a trademark, while also having the capability to be used and understood in a merely descriptive sense. That is the basis for the defense of descriptive fair use, despite existence of a valid trademark through secondary meaning. 15 U.S.C. § 1115(b)(4); *KP Permanent Make-up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); Restatement (Third) of Unfair Competition § 13 cmt. e, at 109 (1993) (“Protection extends, however, only to the secondary meaning that has attached to the designation. The trademark owner acquires no exclusive right to the use of the term in its original, lexicographic sense.”).

Mr. Freeman’s testimony is entirely consistent. When used with ULC Monastery’s ecclesiastical services, in the way trademarks are typically used, the primary meaning and understanding of the GET ORDAINED mark is as a trademark. 62 TTABVUE 4-5 (¶ 20). However, the phrase GET ORDAINED could also be understood to mean other things, depending in how it is used. 79 TTABVUE 18:4-10 (“Get ordained to join the forces. There’s a thousand meanings I think you can construct those two words and carry it onto another achievement.”).

This evidence shows that the GET ORDAINED mark is suggestive, not descriptive. See *Playtex Products, Inc. v. Georgia-Pacific Corp.*, 390 F.3d 158, 164 (2d. Cir. 2004) (a term that

“could plausibly describe a wide variety of products” is suggestive, not descriptive, in a trademark sense) (Sotomayor, J.). This is because a prospective user or recipient of Applicant’s services must apply some thought or inference to relate the multiple potential meanings of the GET ORDAINED mark to the ecclesiastical services provided by Applicant. As the Sixth Circuit described:

“The ‘5-hour ENERGY’ mark could be characterized as merely descriptive, in the sense that it simply describes a product that will give someone five hours of energy. But that is not the end of such an inquiry. The first question one would ask is how would the energy be transferred? Through food? Through drink? Through injections? Through pills? Through exercise? Also, one would ask what kind of energy is the mark referring to? Food energy (measured in Calories)? Electrical energy? Nuclear energy? With some thought, one could arrive at the conclusion that the mark refers to an energy shot. But it is not as straightforward as NVE suggests. Such cognitive inferences are indicative of ‘suggestive’ rather than descriptive marks.”

Innovation Ventures, LLC v. N.V.E., Inc., 104 U.S.P.Q.2d 1560, 694 F.3d 723, 730 (6th Cir. 2012).

In any event, while the witnesses do not entirely agree on the primary meaning and understanding of the phrase “get ordained” when used in a religious context, they do agree that any non-trademark significance would only refer to an act undertaken by an individual, not the service provided by an organization. See, e.g., 62 TTABVUE 4 (¶ 17) (“To ‘get ordained’ is an internal recognition or epiphany of a spiritual calling, which one can only experience within oneself.”); 66 TTABVUE 170:24-171:15 (“I don't possibly see how United National Ministry could become a minister itself; it's an organization.”); 69 TTABVUE 42:20-24 (The phrase “get ordained” describes “something that an individual can do.”); 74 TTABVUE 16:11-20 (“Get ordained means the act of...seeking to receive a title or authority. . .”).

Yet, a phrase is merely descriptive if it directly describes a characteristic of the goods or services, not the actions of the prospective users of those services:

[T]he Fourth Circuit has described a mark as descriptive if it "identifies *a characteristic or quality of an article or service*, [which may include] color, odor, functions, dimensions, or ingredients." *Dayton*, 917 F.2d at 839 (citing 3 L. Altman, Callman Unfair Competition, Trademarks, and Monopolies, § 18.03, ch. 18, at 11 (4th ed.1983)). Put differently, a descriptive mark is "descriptive of...a desirable *characteristic of the goods*." McCarthy, § 11:16; *see also Educational Development Corp. v. Economy Co.*, 562 F.2d 26, 29 (10th Cir.1977) (holding that a descriptive mark "conveys to [the customer] the most important *characteristic of its product*.")...

Stafford Urgent Care v. Garrisonville Urgent Care, 224 F.Supp.2d 1062, 1064 (E.D. Va. 2002) (emphasis added).

Both parties' witness testimony shows that this is not the case with the GET ORDAINED trademark. It therefore takes some thought or inference to relate this individual act or experience to the ecclesiastical services provided by ULC Monastery, and the GET ORDAINED mark is appropriately designated as suggestive. This conclusion is supported by the PTO's regular practice of registering imperative phrases in the "GET _____" form—without requiring a showing of secondary meaning—as suggestive and inherently distinctive. *See* 66 TTABVue 53-113.

2. The GET ORDAINED Trademark Has Acquired Distinctiveness

Even if the Board were to hold that the GET ORDAINED mark is descriptive of ULC Monastery's ecclesiastical services, the evidence demonstrates that the GET ORDAINED mark has acquired distinctiveness through ULC Monastery's long, prominent, and continuous use.⁸ Descriptive marks are registrable and protectable as trademarks where they have acquired distinctiveness—or secondary meaning—as a trademark. *See Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 128 U.S.P.Q.2d 1370, 906 F.3d 965, 969 (Fed. Cir. 2018); *Two Pesos, Inc. v. Taco*

Cabana, Inc., 505 U.S. 763, 766, 112 S. Ct. 2753, 120 L.Ed.2d 615 (1992) (“This acquired distinctiveness is generally called ‘secondary meaning.’”). Secondary meaning “occurs when, in the minds of the public, the primary significance of a mark is to identify the source of the product rather than the product itself.” *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211, 120 S. Ct. 1339, 146 L.Ed.2d 182 (2000) (internal quotation marks, brackets, and citation omitted).

ULC Monastery has submitted substantial evidence demonstrating that the GET ORDAINED mark has achieved secondary meaning as a trademark in the minds of the relevant public. Evidence supporting a finding of secondary meaning includes ULC Monastery’s long-term use of the mark as a trademark. The Lanham Act specifically states that substantially exclusive and continuous use of a term as a trademark for five years may constitute prima facie evidence that the mark has acquired distinctiveness. *See* 15 U.S.C. § 1052(f). ULC Monastery has submitted uncontroverted testimony that it has continuously used the GET ORDAINED mark in connection with its Class 45 services for over a decade. 62 TTABVUE 2-3 (¶¶ 7-11).

Evidence of substantial sales of goods or services in connection with the applied-for mark also constitutes evidence of secondary meaning. *See In re Uncle Sam Chemical Co., Inc.*, 229 U.S.P.Q. 233, 235 (T.T.A.B. 1986) (declaration showing considerable sales under the mark sufficient to demonstrate secondary meaning); *see also 7-Eleven, Inc. v. Wechsler*, 83 U.S.P.Q.2d 1715, 1722 (T.T.A.B. 2007) (noting sales figures as evidence of “recognition and renown”). Here, ULC Monastery has presented such evidence. Hundreds of thousands of individuals have used the

8 AMM argues that the Board should ignore acquired distinctiveness. 88 TTABVUE 42 n.2. Yet, AMM asserted a claim that “the mark is not inherently distinctive and has not acquired distinctiveness,” has not withdrawn that claim, and argued that claim in its Trial Brief. 1 TTABVUE 1-2, 88 TTABVUE 42-46. The Board has already ruled that this puts the matter properly at issue in this proceeding. 36 TTABVUE 11 n.8.

ecclesiastical services provided under the GET ORDAINED mark to become ULC Monastery ministers. 63 TTABVUE 4 (¶ 18), 5-6 (¶¶ 23-25). ULC Monastery has spent nearly \$1 million advertising its services provided under the GET ORDAINED mark. 63 TTABVUE 6-7 (¶¶ 27-29). ULC Monastery has completed over \$10 million in sales through the online store services offered under the GET ORDAINED mark. 63 TTABVUE 7-8 (¶¶ 30-36). This evidence, coupled with Applicant's decade-long use of the GET ORDAINED mark, is sufficient to demonstrate that the GET ORDAINED mark has acquired secondary meaning (if it were not already inherently distinctive).

AMM claims that this long use of the GET ORDAINED trademark cannot show secondary meaning because others have also used the phrase "GET ORDAINED." 88 TTABVUE 42, 44. First, this claim relies substantially on inadmissible evidence. *See* Appendix A. Moreover, third party uses of the phrase "GET ORDAINED" in some manner or context do not necessarily detract from a finding of secondary meaning, because ULC Monastery was substantially exclusive in its use of the phrase "GET ORDAINED" as a trademark. *See* 15 U.S.C. § 1052(f) ("The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made."). Here, AMM has not provided evidence of any third-party uses of "GET ORDAINED" as a trademark. Indeed, it confirmed that there are no such uses. 66 TTABVUE 129 (Rog. No. 1).

Moreover, "whether or not third party usage effectively prevents [the applied-for mark] from attaining secondary meaning depends on the facts of each case and is but one factor to

consider...one's use need not be exclusive in order to establish secondary meaning.” *Nestle Co. v. Joyva Corp.*, 227 U.S.P.Q. 477, 479 (T.T.A.B. 1985) (citations omitted). This is a common-sense rule. For example, the fact that many people and businesses engage in non-trademark use of the phrase “American airlines” (e.g., “American airlines typically have different labor issues than European airlines”) does not mean the AMERICAN AIRLINES trademark is invalid.

AMM's cited cases are distinguishable. In *Levi Strauss & Co. v. Genesco, Inc.*, the applicant sought to register as trade dress “a protruding plain tab visible on shoes when the shoes are worn.” 742 F.2d 1401, 1402 (Fed. Cir. 1984). However, the evidence showed hundreds of examples of competitors' shoes also bearing a protruding tab like the one the applicant sought to register. *Id.* at 1404. Thus, there was evidence that third parties had used the same device in the same manner as the applicant (i.e., the manner claimed to be trade dress). In *Target Brands, Inc. v. Hughes*, the opposer provided evidence of its own “very substantial” sales and advertising expenditures for its own “Ultimate Polo” shirts. 85 U.S.P.Q.2d 1676, 1682-83 (T.T.A.B. 2007). There is no such evidence in this case.

C. The GET ORDAINED Trademark Functions as a Mark

The Board should deny AMM's opposition because AMM has not proven its claim that the GET ORDAINED trademark fails to function as a mark. AMM's claim appears to be based on the premise that use of a phrase cannot be considered trademark use if the phrase is presented in a stylized manner. AMM has cited no authority for this proposition. In contrast, the TMEP gives numerous examples showing that use of a word mark in stylized form, just as ULC Monastery has done, constitutes valid trademark use of the word mark itself. *Compare* 62 TTABVUE 3 (¶¶ 9-11), 7, 9, 65 TTABVUE 3 (¶¶ 9-11), 7-11, *with* TMEP § 1301.04(i).

Moreover, the evidence shows that ULC Monastery also uses the GET ORDAINED mark in many non-stylized forms as well:

- ULC Monastery published copyright notices claiming copyright in the name of “Get Ordained” on the footer of its GetOrdained.org website. 65 TTABVUE 7-8.
- ULC Monastery published an “About” page with the heading “About Get Ordained™” and which stated “Here at Get Ordained™, legal ordination is just a few clicks away, “[U]sing Get Ordained™ is hassle-free,” and “[W]e encourage you to visit the Get Ordained™ Training Center for assistance.” 65 TTABVUE 10-11.
- ULC Monastery published contact information identifying the source of its GetOrdained.org website as “Get Ordained™ / Universal Life Church” and “Get Ordained/Universal Life Church.” 65 TTABVUE 7-8, 10-11.
- ULC Monastery telephone operators orally use the GET ORDAINED trademark to refer to the source of ULC Monastery’s ecclesiastical services (e.g., “You became a minister through GET ORDAINED, right?”). 65 TTABVUE 4 (¶ 15).

Accordingly, AMM has failed to provide any legal or factual support for its claim that the GET ORDAINED trademark fails to function as a mark.

VI. CONCLUSION

For the reasons discussed above, Defendant respectfully requests that the Board deny AMM's opposition.

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Respectfully submitted:

MATESKY LAW^{PLLC}

s/ Michael P. Matesky, II/

Michael P. Matesky, II
(Washington Bar No. 39586)
4500 9th Ave. NE, Suite 300
Seattle, WA 98105
Ph: 206.701.0331
Fax: 206.702.0332
Email: mike@mateskylaw.com;
litigation@mateskylaw.com

Attorney for Defendant

Appendix A – Evidentiary Objections

The trial brief submitted by Opposer American Marriage Ministries (“AMM”) relies almost entirely on evidence that is inadmissible under the Federal Rules of Evidence, Federal Rules of Civil Procedure, and Board precedent, as set forth in greater detail below.

A. The Board Should Exclude Documents AMM Withheld in Discovery

MM’s trial evidence is a textbook example of sandbagging and “trial by surprise” that the Federal Rules of Civil Procedure are designed to prevent. Nearly all of the exhibits to the Wall, Yoshioka, and King testimony depositions were withheld from ULC Monastery in discovery, despite their clear responsiveness to ULC Monastery’s document requests, and AMM’s admission that it had access to these documents long before trial, and in many cases specifically collected the documents for the purpose of using them in this case. This automatically results in their exclusion under Fed. R. Civ. P. 37(c)(1).

ULC Monastery served requests for documents including:

“All documents tending to support, contradict, prove, or disprove the claim that the term “get ordained” is generic in relation to ordination services or any Applied-For Services.” (Request No. 7);

“All documents tending to support, contradict, prove, or disprove the claim that there are other competing businesses offering services similar to Applicant’s services, or any Applied-For Services, who also use the term “get ordained” to describe such services or what such services enable customers to do.” (Request No. 8); and

“For each of the Applied-For Services, all documents tending to support, contradict, prove, or disprove the claim that Applicant’s GET ORDAINED Mark is generic when used in connection with such service.” (Request No. 16).

See 66 TTABVUE 147-49. AMM did not object to any of these Requests, and stated that it in fact would produce responsive documents. 66 TTABVUE 155-57. In fact, AMM withheld numerous responsive documents that it now seeks to rely upon.

Appendix A – Evidentiary Objections

1. AMM Withheld Exhibits 1-21, 23-25 to the Wall Deposition.

AMM admits that Exhibits 1-21 and 23-25 to the Sept. 4, 2020 testimony deposition of Dylan Wall are responsive to ULC Monastery's Requests 7, 8, and/or 16. *See* 90 TTABVUE 10:24-11:2, 11:20-12:6, 16:8-12, 18:18-22, 18:25-19:4, 19:25-20:3, 20:6-11, 21:1-22:17, 23:4-24:6, 24:23-25:3, 25:12-17, 26:3-10, 26:17-27:3, 27:13-28:15, 29:7-30:1, 30:5-6, 21-24, 31:12-21, 32:9-33:5.

Mr. Wall testified that these documents were in AMM's possession long before trial in this case. 69 TTABVUE 34:9-15, 35:2-8, 40:14-16, 44:13-16, 49:9-14, 52:25-50:3, 55:3-5, 59:12-14, 64:9-11, 69:3-5, 72:16-18; 77:10-12, 81:21-22, 86:19-21, 89:15-17, 92:19-23, 95:13-14, 101:8-9, 105:3-6, 108:22-23, 110:15-19, 113:14-15, 117:9-12, 122:17-18, 126:5-6, 129:20-21, 134:19-20. Indeed, he testified that most of these documents were specifically identified for use in this case over two years before trial began. *Id.* at 34:9-15, 59: 18-22.

Yet, AMM withheld all but Exhibit 22 throughout the discovery period and beyond. Despite their obvious and admitted responsiveness, AMM's admitted intent to use these documents at trial, and AMM's admitted possession of these documents prior to trial, AMM did not produce the other 24 exhibits (Exhibits 1-21, 23-25) documents until trial.

2. AMM Withheld All Exhibits (Exhibits 26-46) to the Yoshioka Deposition.

None of the 21 exhibits (Exhibits 26-46) to the trial testimony of Glenn Yoshioka were produced in discovery. There is no question these documents are responsive to (at the very least) ULC Monastery's Request Nos. 7-8, and 16 regarding alleged genericness of the words "get ordained." Mr. Yoshioka himself claimed that the third party organizations he discussed in his testimony (i.e., the uses shown in Exhibits 26-46 to his deposition) use the term in a "generic"

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sense. 74 TTABVUE at 53:12-18, 200-33 (Exs. 26-46). AMM also relies on Mr. Yoshioka's testimony regarding such exhibits to argue that use of "get ordained" is "not as a brand." 88 T.T.A.B.U.E 18. AMM does not dispute that the documents were responsive to ULC Monastery's Requests. *See* 88 TTABVUE 31-32.¹

Again, this is not a case where AMM "discovered" such documents after the close of discovery or immediately prior to trial. Mr. Yoshioka admitted that he regularly accessed and reviewed the web pages reflected in Exhibits 26-46 specifically for their alleged use of the words "get ordained" long before trial. 93 TTABVUE 35:13-36:2, 37:4-39:1, 39:8-40:2, 40:4-16. Yet, despite this, despite AMM's claim that these documents are directly relevant to the main issue in this opposition proceeding, and despite AMM's claim that it was producing all such documents, AMM did not produce these documents in discovery. Rather, AMM sat on them until trial. This is textbook sandbagging, and warrants the exclusion of these documents from trial.

3. AMM Withheld All Exhibits (Exhibits 47-49, 100-03) to the Lewis King Testimony Depositions.

AMM used the same sandbagging strategy for Google Trends data, Wayback Machine captures, and a Google Scholar results summary introduced as trial exhibits (Exhibits 47-49), 100-03) to the testimony of Lewis King. Again, there is no question that these documents are responsive to, at least, ULC Monastery Request Nos. 7-8, and/or 16. Indeed, Mr. King claims these exhibits show that consumers use the words "get ordained" in a generic fashion rather than as a "brand." *E.g.*, 91 TTABVUE 53:4-17; *see also* 88 TTABVUE 30. AMM does not dispute that these documents are responsive to ULC Monastery's discovery requests. *See* 88 TTABVUE at 31-32.

¹ Although AMM argues that it "permissibly reserved its right to use additional documents at trial," 88 TTABVUE 32, AMM cites no authority for the absurd proposition that it can "reserve the right" not to comply with its discovery obligations under Fed. R. Civ. P. 26.

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Again, these documents were not “discovered” after the close of discovery. Mr. King admitted that he regularly accessed these documents and data prior to trial. 91 TTABVUE 8:19-9:1, 8-16, 9:8-16, 12:7-15. Indeed, Mr. King commented on how readily accessible such data is to AMM. 73 TTABVUE 115:18-19 (“[I]t’s so easy to access”). Yet, again, despite its regular use and access of such data, AMM withheld this ESI throughout the discovery process, and introduced it for the first time at trial.

4. There is No Justification for AMM’s Sandbagging

A party may not introduce evidence that it failed to produce in discovery as required by Fed. R. Civ. P. 26(a) or (e), unless the failure was substantially justified or is harmless. Fed. R. Civ. P. 37(c)(1). This is a self-executing sanction for failure to abide by discovery obligations. *Zhang v. Am. Gem Seafoods, Inc.*, 339 F.3d 1020, 1028 (9th Cir. 2003) (strictly following Rule 37 to exclude document when it was produced after discovery cut-off date; and after deposition for which document was to be used; and no “substantial justification” given for failure to produce); Fed. R. Civ. P. 37(c)(1) advisory committee notes (1993) (“The revision provides a self-executing sanction for failure to make a disclosure required by Rule 26(a)....”). The rule is “is intended to prevent the practice of 'sandbagging' an opposing party with new evidence.” *New World Solutions, Inc. v. NameMedia Inc.*, 150 F.Supp.3d 287, 304, 311 (S.D.N.Y. 2015) (excluding, *inter alia*, screenshots of websites not produced in discovery).

Here, there is no justification for AMM’s sandbagging. AMM’s trial strategy was clear. AMM always intended to introduce evidence of third party websites and Google results at trial, had all the relevant documents and data available, but didn’t produce the documents and data in discovery, despite telling ULC Monastery it was producing all such evidence. AMM tried to

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give itself cover by “reserving the right” to produce additional documents at trial and waiting until the last moment to generate copies of the documents and data it always intended to use.

First, a litigant cannot “reserve the right” to violate its obligations under Rule 26 and 34, and exempt itself from the consequences under Rule 37. Second, a litigant is obligated to produce responsive documents and data that it regularly accesses and knows to be responsive to discovery requests, regardless of whether it creates permanent copies stored on its own drives. *See Columbia Pictures, Inc. v. Bunnell*, 245 F.R.D. 443, 446 (C.D. Cal. 2007) (data temporarily stored in computer RAM is information subject to discovery). The *Columbia Pictures* court relied in part on Notes of the Advisory Committee to the 2006 Amendments to Rule 34, noting the broad scope of electronically stored information subject to discovery:

The wide variety of computer systems currently in use, and the rapidity of technological change, counsel against a limiting or precise definition of electronically stored information. Rule 34(a)(1) is *expansive* and includes *any type of information that is stored electronically*. A common example often sought in discovery is electronic communications, such as e-mail. The rule covers—either as documents or as electronically stored information—information “stored in any medium” to encompass future developments in computer technology. Rule 34(a)(1) is intended to be broad enough to cover *all current types of computer-based information*, and flexible enough to encompass future changes and developments.

Id. at 447 (citing Fed. R. Civ. P. 34(a)(1) (2006 amendments) advisory committee's note) (emphasis in *Columbia Pictures*); *see also Bank of New York v. Meridien BIAO Bank Tansania Ltd.*, 171 F.R.D. 135, 146 (S.D.N.Y. 1997) (“[D]ocuments are considered to be under a party's control when the party has the right, authority, or practical ability to obtain the documents from a non-party to the action.”) (emphasis added).

This case illustrates why Rule 34 is and should be broadly applied to electronic media. This is not a case where a litigant “discovers” new evidence after the close of discovery. *Cf.* 88 TTABVUE 31 (discussing cases where “a party discovers additional evidence”). AMM testified

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unambiguously that it had all this evidence available during the discovery period and specifically searched for this evidence to use in this case. Mr. King even remarked on how easy it was to obtain the documents at the push of a button. Yet, AMM was just careful not to make permanent copies on its own computers until trial, thinking that this strategy would allow it permissibly sandbag ULC Monastery at trial.

As the cases cited above make clear, this practice is not allowed under the Federal Rules of Civil Procedure. If it were, it would be a “get out of discovery free card” to any technologically savvy litigant. AMM should not benefit from such gamesmanship. That is exactly the type of behavior Rule 37 is designed to prevent.

B. The Board Should Exclude AMM’s Evidence for Lack of Authentication

AMM relies heavily on alleged screen captures of third party websites that have not been authenticated. These exhibits are not self-authenticating, and AMM did not provide proper authenticating testimony. In order to be self-authenticating, internet printouts must show the date the internet materials were accessed and their source (URL). *See* 37 C.F.R. § 2.122(e)(2); *Safer, Inc. v. OMS Investments, Inc.*, 94 U.S.P.Q.2d 1031 (T.T.A.B. 2010).

1. Exhibits to the Wall Deposition Lack Authentication

Exhibits 2-14, 17, 21-22, and 24-25 to the September 4, 2020 Deposition of Dylan Wall do not display the date the sites or pages in question were accessed (and Exhibit 17 also does not display a URL). 69 TTABVUE 235-47, 255-57, 269-70, 278-79. Similarly, Mr. Wall could not authenticate these documents by testimony, because he also could not testify as to the date the sites or pages were accessed or captured. Rather, the best he could do was provide a stretch of weeks in which he thought the sites or pages were probably accessed. 69 TTABVUE 34:9-15,

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44:13-16, 49:9-14, 52:25-50:3, 55:3-5, 59:12-14, 64:9-11, 69:3-5, 72:16-18; 77:10-12, 81:21-22, 86:19-21, 89:15-17, 92:19-23, 105:3-6, 108:22-23, 110:15-19, 122:17-18, 129:20-21, 134:19-20.

Moreover, his testimony revealed that he did not have personal knowledge of their capture or creation. He did not create the documents. He did not witness their creation. Rather, he delegated that task to other individuals. 69 TTABVUE 34:9-15, 35:2-8, 57:4-8, 157:2-16, 158:4-13, 159:3-13, 160:5-13, 161:19-162:5, 162:17-25, 163:17-164:2, 164:12-21, 165:2-10, 165:18-166:19, 167:2-8, 167:17-168:2, 168:14-22, 169:15-19, 170:11-16, 170:17-171:8, 172:9-173:23, 174:14-175:2, 175:9-24. But those individuals never provided any authenticating testimony for these Exhibits.

With regard to Exhibit 25, the document is not self-authenticating because it does not accurately display a URL source (the URL web.archive.org does not display the page in question), and does not display any date of access. 69 TTABVUE 259. Mr. Wall also could not identify the date of access. 69 TTABVUE 134:18-20. Moreover, Exhibit 25 has not been authenticated for purposes of proving the truth of the information presented therein, namely, that the theamm.org website actually displayed the content in question as of the date in question. “If a party wishes to rely on the Wayback Machine evidence not just for what it shows on its face but to establish that the webpages submitted were displayed on various dates in the past, (“the truth of the capture of the archive date”), witness testimony must be offered to authenticate the printouts and lay the foundation that the webpage printouts are business records.” TBMP §

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704.08(b) (citing *Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 U.S.P.Q.2d 48324, at *3-4 (T.T.A.B. 2020)). AMM provided no such testimony.²

Moreover, in at least some cases, AMM seeks to introduce the websites of third-party organizations captures for the truth of the statements contained therein (i.e., that they actually provide the same ecclesiastical services, or have a large number of priests). See 69 TTABVUE 255; 88 TTABVUE 45 (citing Church of the Latter Day Dude website for claim that the organization has 450,000 members). That is hearsay if the exhibits are not properly authenticated as some hearsay exception. Fed. R. Evid. 801.

2. Exhibits to the Yoshioka Deposition Lack Authentication

None the exhibits to the Yoshioka testimony deposition are self-authenticating, because they do not display any URL or date of capture. 74 TTABVUE 200-233. Mr. Yoshioka himself did not provide necessary authenticating testimony. He either could not identify, or was at best uncertain about, the URL for Exhibits 31-34, 37-39, 43-44. 74 TTABVUE 77:24-78:3, 79:12-16, 81:24-82:3, 85:8-11, 90:17-20, 95:14-19, 97:23-98:2, 100:23-101:4, 101:9-15, 112:19-22, 116:20-117:9. He could not identify the date of access or creation for Exhibit 45, and did not actually create or have personal knowledge regarding the creation of Exhibit 45. 74 TTABVUE 23:8, 24:4-7, 168:3-5, 14-15, 170:14-19. He also did not explain how he went about creating or accessing the pages displayed in Exhibits 29 or 35 (e.g., what search terms were submitted, what

² AMM suggests that ULC Monastery's position regarding authentication of Wayback Machine printouts is hypocritical. 88 TTABVUE 32 ("Applicant objects to the authenticity of documents obtained from the Internet Archive Wayback Machine—while itself offering documents from the Wayback Machine"). This is obfuscation. AMM did not provide sufficient authenticating testimony, and ULC Monastery did. ULC Monastery provided testimony that the Wayback Machine printouts accurately captured the appearance of the websites in question on stated historical dates, from a witness with actual personal knowledge regarding the appearance of the pages in question on those stated historical dates. 63 TTABVUE 3-4, 7-11. AMM did not provide similar testimony.

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punctuation was used (if any), what browser was used, whether he was logged into an account, etc.). 74 TTABVUE 70:22-25, 87:22-25.³

3. Exhibits to the King Depositions Lack Authentication

AMM also failed to authenticate Exhibits 47-49 and 100-103 to the Lewis King deposition testimony. They are not self-authenticating, as there is no URL or date of capture for Exhibits 47, 100-03, and Exhibits 48-49 are simply columns of numbers created for use in this litigation. 73 TTABVUE 145-48, 83 TTABVUE 53-56. With regard to Exhibits 100-02, the dates and URLs displayed on the exhibits are not the URL of the Wayback Machine website or the date the Wayback Machine website was accessed. Rather, they are allegedly the date and URL of the historical websites supposedly captured by the Wayback Machine.

Mr. King could not provide authenticating testimony for Exhibits 48-49 or 100-03. Mr. King did not know the URL or date of access for Exhibits 100-02, and testified that he was not personally involved in creating the screen captures. 83 TTABVUE 32:20-21, 33:25-34:13, 35:16-36:10, 36:23-37:18. Mr. King also had no personal knowledge regarding the creation of Exhibits 48-49 or 103, and assumes they were created by AMM's counsel (at least, Mr. King himself did not create the Exhibits). 73 TTABVUE 119:7-12, 121:21-123:4; 83 TTABVUE 38:9-16, 39:7-21.

Moreover, AMM relies on these documents for the truth of the information shown therein, but has not authenticated them for that purpose. Exhibits 47-49 are introduced solely for the purpose of using the information presented therein as if it were truthful and factual. *See generally* 73 TTABVUE 59-79. Mr. King's testimony regarding these exhibits is simply

³ Exhibits 29 and 35 to the Yoshioka deposition (and Exhibit 103 to the King deposition) are further inadmissible because they simply contain links to documents not otherwise made of record. *Edom Labs. Inc. v. Lichter*, 102 U.S.P.Q.2d 1546, 1550 (T.T.A.B. 2012) ("As for the Google® search summary, it is further inadmissible because it merely offers links to information not otherwise of record.").

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relaying out-of-court statements made by a third party (Google) for the truth of those statements. *E.g.*, 73 TTABVUE 61:11-23, 85:18-21. That is hearsay. Fed. R. Evid. 801(c).

Mr. King has never worked for Google and has no personal knowledge regarding the methodology of recording or compiling the information presented by Google, nor its veracity (i.e., he has no personal knowledge regarding how many people searched Google for any particular term at any particular time; he is just relaying what Google says about it). 73 TTABVUE 123:17-18. AMM has therefore not authenticated Exhibits 47-49 as Google business records or any other exception to the prohibition on hearsay.

The same is true of the Wayback Machine printouts in Exhibits 100-02. He has not laid any foundation to authenticate these documents as business records because he is not an employee of the Internet Archive and has no personal knowledge regarding Internet Archive methodology. 83 TTABVUE 42:25-43:6; *See* TBMP § 704.08(b) (citing *Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 U.S.P.Q.2d 48324, at *3-4 (T.T.A.B. 2020)).

Similarly, Mr. King cannot authenticate those captures as accurate depictions of AMM's historical websites based on his independent knowledge, because Mr. King was not employed by AMM until 2018, and therefore has no personal knowledge on which to base such testimony. 83 TTABVUE 11:5-7. He confirmed that he did not in fact view the web pages in question on the historical dates in question (or at least could not recall doing so). 83 TTABVUE 33:12-20, 36:16-22, 37:20-38:4.

Rather, Mr. King admitted that the only bases for his testimony regarding historical versions of AMM's website is (a) what other people told him in out-of-court statements, and (b) his review of Wayback Machine captures. 83 TTABVUE 16:11-18, 17:8-12, 31:21-32:4. Hearsay is not a sufficient basis for Mr. King's testimony. Fed. R. Evid. 602 ("A witness may

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testify to a matter only if evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter.”). Moreover, Mr. King cannot authenticate the accuracy of Wayback Machine captures solely by reference to the Wayback Machine captures themselves. That is tautological bootstrapping, not authentication.

C. The Board Should Exclude AMM’s Undisclosed Expert Opinion Testimony

The Board should exclude the opinion testimony of Glenn Yoshioka and Lewis Wall regarding analysis of Google data and third-party understanding of “GET ORDAINED” trademark because AMM did not properly disclose such testimony as required under the Federal Rules of Civil Procedure or establish its admissibility under the Federal Rules of Evidence. A party must disclose such testimony, and establish that such testimony is “the product of reliable principles and methods.” Fed. R. Evid. 26(a)(2)(A); Fed. R. Evid. 702(c). AMM did neither.

Mr. Yoshioka and Mr. King both gave opinion testimony regarding the beliefs, thoughts, understandings, and intentions of third parties when they use the phrase “GET ORDAINED.” Clearly, this is not fact testimony, and they have no personal knowledge regarding what other people are thinking. Rather, they based this opinion testimony on their claimed expertise in analyzing Google search, analytics, and “trends” data.

For example, Mr. Yoshioka testified that third parties searching Google for the phrase “GET ORDAINED” by itself are using the phrase in a generic sense, without referring to a particular source of ecclesiastical services. 74 TTABVUE 142:3-18. He based this conclusion on his supposedly best-in-the-nation expertise at analyzing such data tools. *See* 74 TTABVUE 142, 22-25, 143:5-10.

Mr. King also testified that he knows “what other people are looking for” when they search Google using the “GET ORDAINED” phrase, because of his expertise in analyzing data

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provided through the Google Trends platform. 73 TTABVUE 52:3-7, 53:7-11; *see also* 88 TTABVUE 30 (regarding King’s supposed “in-depth analyses of searches for ‘get ordained’ by members of the public” using the Google Trends platform and data). Mr. King reached the opposite conclusion in comparison to Mr. Yoshioka. Namely, Mr. King concluded that when people search Google for the phrase “GET ORDAINED” with additional material added, that means they do not view the phrase “as a brand.” *See* 88 TTABVUE 30; 73 TTABVUE 54:20-25, 55:14-17.

Such web traffic and search analytics opinions constitute expert opinion testimony admissible only under Fed. R. Evid. 702. *See Gen. Steel Domestic Sales, LLC v. Chumley*, 10-cv-01398-PAB-KLM, ** 3-5 (D. Colo. Apr. 20, 2012) (analysis of search engine rankings to show brand awareness is expert opinion testimony, not lay opinion testimony); *see also J.T. Colby & Co. v. Apple Inc.*, No. 11 Civ. 4060 (DLC), ** 36-37 (S.D.N.Y. May 8, 2013) (lay witness cannot give speculative or inferential testimony regarding third-parties’ supposed brand recognition).

Under, Fed. R. Civ. P. 26(a)(2)(A), AMM was required to disclose any witnesses that would provide expert opinion testimony under Fed. R. Evid. 702. AMM did not disclose Mr. Yoshioka or Mr. King as expert witnesses. Moreover, Mr. Yoshioka’s and Mr. King’s opinions are not “the product of reliable principles and methods” as required to be admissible under Fed. R. Evid. 702(c).

This is shown clearly by the fact that they reach contradictory conclusions. Mr. Yoshioka opines that use of “GET ORDAINED” as a search term by itself shows that users view the term generically. Mr. King opines that use of “GET ORDAINED” with additional material shows that users view the term generically. It is obvious that both witnesses simply started with the

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assumption that “GET ORDAINED” is not recognized as a brand, and constructed self-interested, post-hoc rationales to explain how the Google data could support that pre-ordained conclusion. That is not an example of “reliable principles and methods.” Fed. R. Evid. 702(c). Accordingly, such opinion testimony should be excluded.

D. The Board Should Exclude Mr. King’s Hearsay Testimony

AMM relies on Mr. King’s testimony regarding what actual and prospective ministers supposedly told him in out-of-court statements to prove that such individuals do not understand the GET ORDAINED trademark to refer to a single source of ecclesiastical services. *See* 88 TTABVUE 30-31 (and King testimony cited therein). In other words, the declarants supposedly told Mr. King how they use and understand the phrase “GET ORDAINED,” and Mr. King relayed those statements prove the truth of the matter asserted (i.e., that the declarants do not view the GET ORDAINED mark as a source indicator). That is classic hearsay. *See* Fed. R. Evid. 801.

CERTIFICATE OF SERVICE

I hereby certify that I served the foregoing on Opposer's counsel of record by email transmission to nancy.stephens@foster.com, pursuant to Trademark Rule § 2.119(b), 37 C.F.R. § 2.119(b).

Dated: August 30, 2020

s/ Michael P. Matesky, II
Michael P. Matesky, II